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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/691,028	10/22/2003	James Russell Curtis	200314220-1	5010
22879 7590 10/24/2008 HEWLETT PACKARD COMPANY P O BOX 272400, 3404 E. HARMONY ROAD INTELLECTUAL PROPERTY ADMINISTRATION FORT COLLINS, CO 80527-2400				
EXAMINER				
DAO, THUY CHAN				
ART UNIT		PAPER NUMBER		
2192				
NOTIFICATION DATE		DELIVERY MODE		
10/24/2008		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/691,028

Applicant(s)

CURTIS ET AL.

Examiner

Thuy Dao

Art Unit

2192

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07/28/08.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-6, and 8-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-6 and 8-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/S508)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. This action is responsive to the amendment filed on July 28, 2008.
2. Claims 1, 3-6 and 8-10 have been examined.

Response to Amendments

3. In the instant amendment, claims 6 and 8-10 have been amended.

Response to Arguments

4. Applicants' arguments have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections – 35 USC §101

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claims 6 and 8-10 are directed to "A computer program product comprising computer-readable media encoded with a set of computer programs including: ...", in which the computer-readable media may comprise only transmission media (specification, page 6, lines 7-9).

A computer readable medium product is a tangible physical article or object, some form of matter, which a signal is not. That the other two product classes, machine and composition of matter, require physical matter is evidence that a manufacture was also intended to require physical matter. A signal, a form of energy, does not fall within either of the two definitions of manufacture. Thus, a signal does not fall within one of the four statutory classes of Sec. 101 – see MPEP 2106

Under the principles of compact prosecution, claims 6 and 8-10 have been examined as the Examiner anticipates the claims will be amended to obviate these 35 USC § 101 issues. For example, - A computer program product comprising computer-

readable storage media encoded with a set of computer programs including: ... - as disclosed in page 4, lines 19-21.

Claim Rejections – 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1, 3-6, and 8-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 2004/0003266 A1 to Moshir et al. (art made of record, hereinafter “Moshir”) in view of US Patent No. 6,678,888 to Sakanishi. (art made of record, hereinafter “Sakanishi”).

Claim 1:

Moshir discloses *a method comprising:*

launching an application on a user system (e.g., FIG. 5, target computer 500, [0118]-[0121]; software and patches installed/launched in said target computer 500, [0086]-[0092]);

tracking usage of said application so as to generate usage data on said user system (e.g., [0010]-[0018]; FIG. 6, usage/software/hardware info 604-608, [0099]-[0100]);

accessing an update site from said user system (e.g., FIG. 2, update server 220, package computer 230; FIG. 5 and related text);

transferring said usage data from said user system to said update site (e.g., FIG. 8, blocks 812-820, [0096]-[0097]; FIG. 7, [0143]-[0146]);

said update site prioritizing updates for said application (e.g., [0149]-[0152], [0181]); *and*

said update site presenting to a user a list of said contents as prioritized in said prioritizing step (e.g., FIG. 6, block 706, [0144]-[0147]; FIG. 5, [0129], notification means 516, [0132]; [158] and [0187]).

Moshir does not explicitly disclose said update site prioritizing contents for said application at least in part as a function of said usage data.

However, in an analogous art, Sakanishi further discloses:

usage data (e.g., FIG. 3, col.7: 23-40; FIG. 12, col.9: 56 – col.10: 10);

said update site prioritizing updates for said application at least in part as a function of said usage data (e.g., FIG. 7, col.8: 29-42; FIG. 12, col.9: 56 – col.10: 10; FIG. 18, col.11: 42 – col.12: 46); and

said update site presenting to a user a list of said contents as prioritized in said prioritizing step (e.g., FIG. 25-26, col.15: 32-64).

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to combine Sakanishi's teaching into Moshir's teaching. One would have been motivated to do so to efficiently handle software distribution as suggested by Sakanishi (e.g., col.3: 25-37).

Claim 3:

The rejection of claim 1 is incorporated. Moshir also discloses *said user selects one or more of said updates for said application (e.g., [0158], [0187], [0189], [0191]).*

Claim 4:

The rejection of claim 3 is incorporated. Moshir also discloses *said selected ones of said updates are installed so as to modify said application (e.g., [0122]-[0127]).*

Claim 5:

The rejection of claim 1 is incorporated. Moshir also discloses *further development of said application is directed in part as a function of said usage data (e.g., [0065]-[0070]).*

Claim 6:

Moshir discloses *a computer program product comprising computer-readable storage media encoded with a set of computer programs including:*

a usage data evaluator for receiving and evaluating raw usage data received provided by a user computer system (e.g., [0010]-[0018]; FIG. 6, usage/software/hardware info 604-608, [0099]-[0100]);

regarding a version of a software application installed thereon (e.g., FIG. 5, target computer 500, [0118]-[0121]; software and patches installed/launched in said target computer 500, [0086]-[0092]);

said usage data evaluator providing evaluated usage data (e.g., FIG. 8, blocks 812-820, [0096]-[0097]; FIG. 7, [0143]-[0146]);

an update prioritizer for prioritizing updates available for said version (e.g., [0149]-[0152], [0181]);

a web interface for communicating with said user computer system via a browser on said user system as to present to a user of said computer system a list of said contents as prioritized by said prioritizer (e.g., FIG. 6, block 706, [0144]-[0147]; FIG. 5, [0129], notification means 516, [0132]; [158] and [0187]).

Moshir does not explicitly disclose *an update prioritizer for prioritizing updates available for said version at least in part as a function of said evaluated usage data.*

However, in an analogous art, Sakanishi further discloses:

usage data (e.g., FIG. 3, col.7: 23-40; FIG. 12, col.9: 56 – col.10: 10);

an update prioritizer for prioritizing updates available for said version at least in part as a function of said evaluated usage data (e.g., FIG. 7, col.8: 29-42; FIG. 12, col.9: 56 – col.10: 10; FIG. 18, col.11: 42 – col.12: 46); and

a web interface for communicating with said user computer system via a browser on said user system as to present to a user of said computer system a list of said contents as prioritized by said prioritizer (e.g., FIG. 25-26, col.15: 32-64).

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to combine Sakanishi's teaching into Moshir's teaching. One would have been motivated to do so to efficiently handle software distribution as suggested by Sakanishi (e.g., col.3: 25-37).

Claim 8:

The rejection of claim 6 is incorporated. Moshir also discloses *said web interface specifies, for at least some of said updates, advantages over said version of said application* (e.g., [0019]-[0026]).

Claim 9:

The rejection of claim 6 is incorporated. Moshir also discloses *a usage-tracking module installed on said user computer system* (e.g., [0129]-[0132]).

Claim 10:

The rejection of claim 9 is incorporated. Moshir also discloses *said usage-tracking module is integrated with said version of said application* (e.g., FIG. 4, monitor module, [0078]-[0086]).

Conclusion

9. Any inquiry concerning this communication should be directed to examiner Thuy Dao (Twee), whose telephone/fax numbers are (571) 272 8570 and (571) 273 8570, respectively. The examiner can normally be reached on every Tuesday, Thursday, and Friday from 6:00AM to 6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tuan Q. Dam, can be reached at (571) 272 3695.

The fax phone number for the organization where this application or proceeding is assigned is (571) 273 8300.

Any inquiry of a general nature of relating to the status of this application or proceeding should be directed to the TC 2100 Group receptionist whose telephone number is (571) 272 2100.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Thuy Dao/
Examiner, Art Unit 2192

/Tuan Q. Dam/
Supervisory Patent Examiner, Art Unit 2192